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PATENT APPLICATION

ATTORNEY DOCKET NO. 10004141-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John F. Meyer

Confirmation No.: 3627

Application No.: 09/785,969

Examiner: Ronald Laneau

Filing Date: Feb. 17, 2001

Group Art Unit: 1762

Title: Method And Apparatus For Accessing And Storing Digital Images

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 8/31/2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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Rev 10/05 (Apt/10)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: John F. Meyer

Examiner: Ronald Laneau

Serial No.: 09/785,969

Group Art Unit: 3627

Filed: February 17, 2001

Docket No.: 10004141-1

Title: METHOD AND APPARATUS FOR ACCESSING AND STORING
DIGITAL IMAGES

APPEAL BRIEF

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1-4, 7-27, 29-34 and 36 are pending. Claims 5-6, 28, 35 and 37 have been canceled. All pending claims have been rejected. The rejection of all pending claims (Claims 1-4, 7-27, 29-34 and 36) is appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

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5. SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 1 is directed to a method for conducting a sales transaction in which a buyer purchases the storage of a digital image from a digital camera at a remote site. One such method is shown in Fig. 1 and described in the Specification at paragraphs 0015 through 0021. In particular, the method of Claim 1 includes the acts of displaying a price for storing the digital image at the remote site (block 110 in Fig. 1 and Specification paragraph 0019), prompting a customer for payment (block 112 in Fig. 1 and Specification paragraph 0019), receiving a payment (block 114 in Fig. 1 and Specification paragraph 0019), and printing a sales receipt that a thumbnail of the image stored at the remote site (block 118 in Fig. 1 and Specification paragraphs 0021 and 0031).

Claim 13 is also directed to a method for conducting a sales transaction in which a buyer purchases the storage of a digital image from a digital camera at a remote site. As noted above for Claim 1, one such method is shown in Fig. 1 and described in the Specification at paragraphs 0015 through 0021. In Claim 13, the acts of accessing the digital image, displaying a price, prompting the customer for payment and receiving payment are performed by a transaction machine, for example, transaction machine 202 shown in Figs. 2 and 3 and described in the Specification at paragraphs 0016-0019 and 0024.

Claim 15 is directed to system for conducting a sales transaction in which a buyer purchases the storage of digital images from a digital camera at a remote site. One such system is shown in Fig. 2 and described in the Specification at paragraph 0024. The acts performed by the system are also described in the Specification at paragraphs 0015-0021. Each element of Claim 15 is a mean plus function. Each element of Claim 15, therefore, is listed below followed in parentheses by the identification of the structure and acts corresponding to each means plus function.

- means for transferring digital images from a customer's digital camera imaging device memory to a remote site (communications interface 304 and memory card reader 314 in Fig. 3; step 104 in Fig. 1; and Specification paragraphs 0016, 0023, 0029 and 0030)

- means for storing the digital images at the remote site (Server 206 in Fig. 2 and Specification paragraph 0024)

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- means for displaying a price for storing the digital images at the remote site (display 312 in Fig. 3 and Specification paragraphs 0019 and 0030);
- means for prompting a customer for payment of the price (display 312 in Fig. 3; step 112 in Fig. 1; and Specification paragraphs 0019 and 0030)
- means for receiving a payment for storing the digital images at the remote site (credit card reader 308 in Fig. 3 and Specification paragraphs 0019 and 0030)
- means for printing a sales receipt including the price paid for storing the digital images at the remote site, the date the payment was received and information identifying the stored images (printer 306 in Fig. 3 and Specification paragraphs 0021 and 0030).

Claim 19 is directed to a mini-kiosk that includes a memory card reader and a processor for performing a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site. One such mini-kiosk is shown in Fig. 3 (mini-kiosk 202, memory card reader 314 and processor 300) and described in the Specification at paragraphs 0029 and 0030.

Claim 24 is directed to a program encoded on a computer memory for use in a transaction machine. The program when executed instructs the processor in the machine to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, send paid-for digital images to the remote site, and to receive confirmation of storage of the paid-for digital images from the remote site. One such program encoded on transaction machine memory 302 in Fig. 3 is described in paragraph 0030 of the Specification.

6. GROUNDS OF REJECTION TO BE REVIEWED.

1. Claims 1-3, 7-10, 13-16, 18-21, 24-27, 30-34 and 36 stand rejected under 35 U.S.C. § 103(a) as being obvious over Parulski (6,836,617) in view of Safai (6,715,003) and Miyamoto (6,456,391).
2. Claims 4, 17, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being obvious over Parulski in view of Safai and www.telepix.com.

7. ARGUMENT.**GROUND NO. 1**

Claims 1-3, 7-10, 13-16, 18-21, 24-27, 30-34 and 36 stand rejected under 35 U.S.C. § 103(a) as being obvious over Parulski (6,836,617) in view of Safai (6,715,003) and Miyamoto (6,456,391).

Claims 1-3, 7-10, 13-16, 18-21, 24-27, 30-34 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Safai and further in view of Miyamoto. The Examiner carries the burden of establishing a prima facie case of obviousness. If the Examiner fails to carry this burden, then the Applicant is under no obligation to present evidence of non-obviousness. The prior art references must teach or suggest all claim limitations. MPEP § 2142. As detailed below, the prior art references do not teach or suggest all claim limitations and, therefore, for this reason alone the Examiner has failed to establish a prima facie case of obviousness.

A. Safai does not teach the acts of prompting a customer for payment of the price and receiving a payment (Claims 1-4, 7-18, 25-27, 29-34 and 36).¹

Claims 1 and 13 recite displaying a price for storing the at least one digital image at the remote site, prompting a customer for payment of the price, receiving a payment for storing the at least one digital image at the remote site, storing the at least one digital image at the remote site, and printing a sales receipt that includes the price paid for storing the at least one digital image at the remote site, the date the payment was received, and a thumbnail of the at least one digital image stored at the remote site. Claim 15 is a system counterpart to method Claim 1 and recites similar limitations.

In the three-way combination relied on by the Examiner, the Examiner asserts that Safai discloses the acts of displaying a price, prompting a customer for payment of the price and receiving a payment. This assertion is not correct.

The passages in Safai cited by the Examiner in support of his assertion are quoted below in full.

"In this context, 'Develop' refers to virtual development of a digital image, that is, transport of a digital image from camera 100 to some external

¹ The distinguishing features noted in Sections A and B for Ground No. 1 apply to dependent Claims 4, 11, 12, 17 and 29 through their respective base claims even though these claims were rejected under a further combination of references (or not at all in the case of Claims 11 and 29).

storage and service location for remote storage, photographic processing, printing, or forwarding." Column 25, lines 45-50.

"Selection screen 1000 may also include a price field that displays a price value representing the cost to the user of camera 100 of preparing and sending the desired quantity of photographic prints. The price value displayed in the price field may be computed and displayed by software elements 220 based on a table of prices stored in the camera or otherwise accessible to the camera. In an embodiment, the table of prices may be updated with new prices in subsequent steps of the process of FIG. 12B when an image is sent for development. Thus, camera 100 may be updated periodically to acquire new price values as processing prices provider, log in using a pre-determined user name and change. To indicate that the displayed price value is acceptable, the user may select the NEXT option 415c." Column 27, lines 30-43.

There is nothing in these passages from Safai that teach or even suggest prompting a customer for payment or receiving payment. So far as Applicant can tell, there is nothing anywhere in Safai that addresses payment. For this reason alone, the Examiner has failed to carry his burden of establishing a prima facie case of obviousness as to Claims 1, 13 and 15 and their respective dependent claims.

B. Miyamoto's index print of thumbnail images is not a sales receipt (Claims 1-4, 7-18, 25-27, 29-34 and 36).

In the three-way combination relied on by the Examiner, the Examiner asserts that Miyamoto discloses the act of printing a sales receipt. This assertion is not correct.

The Examiner argues that Miyamoto's index print of thumbnail images is a sales receipt because "it is the confirmation of all images stored." Final Office Action page 3. A sales receipt is more than a confirmation of images stored. The price paid and the date of payment are inherent characteristics of any sales receipt. Claims 1, 13 and 15 expressly recite a sales receipt that includes the price paid and the date of payment. Miyamoto's index print of thumbnail images does not include these features and there is nothing in Miyamoto, Parulski or Safai that even remotely suggests a receipt that includes the price paid and the date of payment along with the thumbnail images. Miyamoto does not teach or suggest the sales receipt of Claims 1, 13 and 15. For this additional reason, the Examiner has failed to carry his burden of establishing a prima

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facie case of obviousness as to Claims 1, 13 and 15 and their respective dependent claims.

C. The Examiner has made no showing that the combination of Parulski, Safai and Miyamoto teach the mini-kiosk of Claim 19 (Claims 19-21).

Claim 19 recites a card reader and a processor responsive to the card reader. The processor is programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site. In support of the rejection of Claims 19-21, the Examiner states only that "Claims 19-21 are rejected for the same reasons set forth for the method claim above." The Examiner's apparent reference to the method of Claim 1 is misplaced because Claim 19 contains limitations not found in Claim 1. In fact, so far as Applicant can tell, neither Parulski, Safai nor Miyamoto alone or in combination teach or suggest the mini-kiosk of Claims 19-21. Absent some showing to the contrary, the rejection of Claims 19-21 should be withdrawn by the Examiner.

D. The Examiner has made no showing that the combination of Parulski, Safai and Miyamoto teach the article of Claim 24 (Claim 24).

Claim 24 recites a program for instructing a processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site. The Examiner does not specifically address the limitations of Claim 24 in the final Office Action. The Examiner makes some vague assertions at pages 6-7 of the Action about a computer program to "determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site...." These assertions are not supported by citation to any reference. Furthermore, the Examiner's discussion of method Claim 1 does not address the pricing and payment limitations in Claim 24. The Examiner has, therefore, failed to establish a prima facie case of obviousness as to Claim 24.

GROUND NO. 2

Claims 4, 17, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being obvious over Parulski in view of Safai and www.telepix.com.

Claims 4, 17, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Safai and further in view of www.telepix.com. Claims 4, 17 and 22-23 are all dependent claims that are allowable due to their dependence on an allowable base claim (as detailed above). It is not clear if the Examiner intends the combination of Parulski, Safai and telepix as an independent grounds for rejecting the base claims too, or if the Examiner mistakenly failed to also cite to Miyamoto, as in the rejection of the base claims.

In any event, the Examiner asserts that www.telepix.com teaches printing a receipt. The only discussion of a receipt in telepix appears to be on page 3 of the reference – "automatic job order logging and receipt printing." There is no further discussion of printing a receipt or a discussion detailing the form of the receipt in the www.telepix.com reference. In fact, there is some question as to whether this receipt is even a sales receipt. Claim 4 depends from Claim 1 which recites "printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at least one digital image stored at the remote site." Telepix does not teach or even suggest any such receipt.

Claim 17 depends from Claim 15. Claim 17 includes the elements of Claim 15 which recites "means for printing a sales receipt including the price paid for storing the digital images at the remote site, the date the payment was received and information identifying the stored images." Again, telepix does not teach or suggest any such receipt.

Claim 22 depends from Claim 19. Claim 22 includes the elements of Claim 19 which recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

Claim 22 also adds "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." Claim 23

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depends from Claim 22 and adds that the processor commands the printer to print receipts including thumbnails of paid for images. The complete recitations included in Claim 22 (and Claim 19) are not taught in the references.

Respectfully submitted,

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**RECEIVED
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1. (Previously Presented) A method comprising:
transferring at least one digital image from a memory associated with a customer's digital camera imaging device to a memory at a remote site;
displaying a price for storing the at least one digital image at the remote site;
prompting a customer for payment of the price;
receiving a payment for storing the at least one digital image at the remote site;
storing the at least one digital image at the remote site; and
printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at least one digital image stored at the remote site.
2. (Previously Presented) The method of claim 1, further comprising uploading the at least one digital image to the remote site.
3. (Previously Presented) The method of claim 2, wherein the Internet is used to upload the at least one digital image.
4. (Previously Presented) The method of claim 1, further comprising
receiving a plurality of digital images from the memory of the user's digital camera imaging device; and
selecting the at least one digital image from a plurality of digital images.
- 5-6. (Canceled)
7. (Previously Presented) The method of claim 1, wherein transferring the at least one digital image includes reading memory that has been removed from the imaging device.
8. (Original) The method of claim 1, wherein the remote site is a server.

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9. (Original) The method of claim 1, wherein the remote site is an image storage web site.
10. (Previously Presented) The method of claim 1, wherein the digital image is a picture image received from memory of a digital camera.
11. (Previously Presented) The method of claim 1, wherein transferring, displaying, prompting, receiving and printing are performed at a kiosk.
12. (Original) The method of claim 11, wherein the owner of the kiosk has a fee agreement with the owner of the remote storage site.
13. (Previously Presented) A method of storing a digital image captured by a digital camera imaging device, the method comprising:
accessing at least one digital image from a memory from a digital camera imaging device with a transaction machine;
the transaction machine displaying a price for storing the at least one digital image at a remote site;
the transaction machine prompting a customer for payment of the price;
the transaction machine receiving a payment for storing the at least one digital image at the remote site;
storing the at least one digital image at the remote site; and
confirming storage of the at least one digital image at the remote site with a sales receipt that includes the price paid for storing the at least one digital image at the remote site, the date the payment was received and information identifying the at least one digital image stored at the remote site.
14. (Previously Presented) The method of claim 13, further comprising printing the sales receipt and wherein the information identifying the at least one digital image stored at the remote site includes.

15. (Previously Presented) A system comprising:
means for transferring digital images from a customer's digital camera imaging device memory to a remote site;
means for storing the digital images at the remote site;
means for displaying a price for storing the digital images at the remote site;
means for prompting a customer for payment of the price;
means for receiving a payment for storing the digital images at the remote site;
and
means for printing a sales receipt including the price paid for storing the digital images at the remote site, the date the payment was received and information identifying the stored images.
16. (Previously Presented) The system of claim 15, wherein the information identifying the stored images comprises thumbnail images of the stored images.
17. (Previously Presented) The system of claim 15, further comprising means for prompting a user to select at least one of the digital images for storing from the received digital images.
18. (Original) The system of claim 15, further comprising the remote site.
19. (Previously Presented) A mini-kiosk comprising:
a memory card reader; and
a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site, wherein the mini-kiosk is adapted for use by a plurality of customers.
20. (Original) The mini-kiosk of claim 19, further comprising a data communication device, responsive to the processor, for sending the digital images to the remote site.

21. (Original) The mini-kiosk of claim 19, further comprising at least one device, coupled to the processor, for entering payment information.

22. (Original) The mini-kiosk of claim 19, further comprising a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions.

23. (Original) The mini-kiosk of claim 22, wherein the processor commands the printer to print receipts including thumbnails of paid-for images.

24. (Previously Presented) An article for a transaction machine, the transaction machine adapted for use by a plurality of customers, the transaction machine having a processor and an interface, the article comprising:

computer memory linked to the processor, the interface communicatively coupled to the computer memory and the interface adapted to receive digital images from the plurality of customers; and

a program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, send paid-for digital images to the remote site, and to receive confirmation of storage of the paid-for digital images from the remote site.

25. (Previously Presented) The method of claim 4 wherein, selecting the at least one digital image from a plurality of digital images includes a user selecting at least one digital image from a plurality of digital images prior to submitting the at least one digital image to a transaction machine.

26. (Previously Presented) The method of claim 4 wherein, selecting the at least one digital image from a plurality of digital images further comprises:

displaying the plurality of digital images from memory of an imaging device; and
prompting the selection of at least one digital image from the plurality of digital images.

27. (Previously Presented) The method of claim 26 wherein displaying the plurality of digital images from memory of an imaging device is performed on a transaction machine.
28. (Canceled)
29. (Previously Presented) The method of claim 2 wherein uploading the at least one digital image to the remote site further comprises storing the at least one digital image on a recordable medium.
30. (Previously Presented) The method of claim 29 wherein uploading the at least one digital image to the remote site further comprises mailing the recordable medium to the remote site.
31. (Previously Presented) The method of claim 29 wherein the recordable medium is a CD ROM.
32. (Previously Presented) The method of claim 29 wherein the recordable medium is a tape.
33. (Previously Presented) The method of claim 1 wherein the sales receipt further includes a listing of the at least one digital image.
34. (Previously Presented) The method of claim 33 wherein the sales receipt further includes a code for the at least one digital image.
35. (Canceled)
36. (Previously Presented) The mini-kiosk of claim 22, wherein the receipt printer coupled to the processor prints receipts that include thumbnails of the digital images stored as a result of the transaction.
37. (Canceled)

APPENDIX II – EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

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APPENDIX III – RELATED PROCEEDINGS

none

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